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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/790,991  | 03/02/2004  | Mikhail Lotvin       |                     | 1319             |
| 33283   | 7590        | 01/26/2009           | EXAMINER            |                  |
| RICHARD MICHAEL NEMES<br>754 WEST BROADWAY<br>WOODMERE, NY 11598-2948 |             |                      | BOVEJA, NAMRATA     |                  |
|   |             | ART UNIT             | PAPER NUMBER        |                  |
|   |             | 3622                 |                     |                  |
|   |             | MAIL DATE            | DELIVERY MODE       |                  |
|   |             | 01/26/2009           | PAPER               |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/790,991             | LOTVIN ET AL.       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | PINKY BOVEJA           | 3622                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 12 May 2008.  
 2a) This action is **FINAL**.                  2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-85 is/are pending in the application.  
 4a) Of the above claim(s) 1-26, 29-74 and 78 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 27, 28, 75-77, and 79-85 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 02 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

1. This office action is in response to communication filed on 05/12/2008.
2. Claims 1-26, 29-74, and 78 have been cancelled. Claims 27, 28, and 75-77, and 79-85 are presented for examination.
3. Amendments to the claims 27, 28, and 75, and 81-85 have been entered and considered.

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 27, 75, 77, 79-81, 83, and 84 are rejected under U.S.C. 103(a) as being unpatentable over Kamakura et al. Patent Number 6,076,101 (hereinafter Kamakura) in view of the article by Shannon Obendorf, titled "Points for loyalty," from Catalog Age, December 1997, Vol. 14, Iss. 13, pg. 35 (hereinafter Obendorf) *and further in view of Official Notice.*

In reference to claims 27 and 80, Kamakura discloses a *computer readable medium and method of providing advertisement to a user communicating with an advertising entity over a network, comprising: sending e-mail comprising an advertisement message identifying a monetary value associated with the advertisement* (col. 1 lines 61 to col. 2 lines 13), wherein the monetary value is displayed in a subject line of the transmitted e-mail, which is displayed to the user before the e-mail is opened

Art Unit: 3622

and a message in a body of the e-mail can be read (col. 3 lines 33-39 and 57-63 and col. 6 lines 20-22 and 62-67); and enabling the user to realize the monetary value associated with the advertisement, comprising the steps of: electronically providing the user with purchasing choices consistent with the monetary value (col. 9 lines 10-53).

*Kamakura teaches the identification of bonus points in a subject line of the transmitted e-mail (col. 3 lines 33-39 and 57-63 and col. 6 lines 20-22 and 62-67).*

*Kamakura does not specifically teach identifying advertised product or service and displaying the advertised product or service in a subject line of an e-mail. Official Notice is taken that it is old and well known to identify an advertised product or service in a subject line of the transmitted e-mail. For example, when a user receives e-mails from retailers, the subject line may say all DVD's on sale, business books on sale, fall coat sale, all shoes on sale, etc. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have included identification information regarding an advertised product or service in a subject line of the transmitted e-mail to enable the user to know before opening the e-mail, if the e-mail is regarding a product that is of interest to the user at that given time.*

*Kamakura does not specifically teach receiving an automatically-generated response from computer of the user indicating that the user has opened the e-mail. Official Notice is taken that it is old and well known to receive an automatically-generated response from computer of the user indicating that the user has opened the e-mail. For example, when a user sends an e-mail using Microsoft Office, he can click on options and check the box for receiving a read receipt for the e-mail message he is*

*sending to receive an e-mail letting him know that the recipient has opened the e-mail. Additionally, America Online provides the feature in the e-mail program called status, and when the user of an America Online e-mail account sends an e-mail to another user of an America Online e-mail account, the sender can click the button for status to know if the recipient has opened his e-mail. Also, marketers such as Intellipost Corp's BonusMail enable users to receive credit toward merchandise and services every time the user opens up a promotional e-mail and therefore inherently need to know that the user opened an e-mail to reward those credits. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have included receiving an automatically-generated response from computer of the user indicating that the user has opened the e-mail to provide the user some incentive for simply opening an e-mail and additional incentives for taking an action regarding the advertising received by the user.*

Kamakura does not specifically teach electronically determining the user's selection and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection. Obendorf teaches electronically determining the user's selection (page 1 paragraph 4, page 2 paragraph 7 and Figure 1, and page 3 paragraphs 1 and 3) and electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection (page 1 paragraph 4, page 2 paragraph 7 and Figure 1, and page 3 paragraphs 1 and 3). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include electronically determining the user's selection and

electronically providing the user's selection to a third-party supplier of goods or services consistent with the user's selection in Kamakura's invention to enable the users to redeem theirs points with retailers that offer products of interest to the users from the convenience of their home by using their computers to order their award items.

5. In reference to claims 75 and 81, Kamakura teaches *the computer readable medium and* the method further comprising transferring the monetary value specified in the e-mail to account of the user (col. 2 lines 8-13, col. 3 lines 10-13 and 43-48, and col. 8 lines 15-28).

6. In reference to claims 77 and 83, Kamakura teaches *the computer readable medium and* the method wherein the monetary value is displayed as points (abstract, col. 3 lines 1-56, col. 4 lines 24-31, col. 5 lines 1-7, col. 6 lines 58-67, col. 8 lines 24-28, and col. 9 lines 10-42).

7. In reference to claims 79 and 84, Kamakura does not teach *the computer readable medium and* the method further comprising electronically receiving a commission from the third-party supplier of goods or services. Obendorf teaches *the computer readable medium and* the method further comprising electronically receiving a commission from the third-party supplier of goods or services (i.e. Edmund Scientific sells products to MotivationNet at a discount, and they buy MyPoints for \$0.016 per point and MotivationNet buys back redeemed points for \$.01) (page 2 paragraph 6). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Kamakura's invention electronically receiving a commission from the third-party supplier of goods or services to enable the reward

program administrator to generate revenues by bringing business to third-party suppliers of goods or services by introducing new customers to the third-party suppliers.

8. Claims 28 and 85 are rejected under U.S.C. 103(a) as being unpatentable over Kamakura in view of Oberndorf and further in view of *Official Notice* and further in view of the Valupage.com website ([www.valupage.com](http://www.valupage.com)) (from date 12/03/1998 captured by the Wayback Machine Internet Archives) (hereinafter Valupage).

In reference to claims 28 and 85, Kamakura teaches the use of conditions in determining the transfer amount of monetary value to the user's account (col. 5 lines 24 to col. 6 lines 11 and col. 7 lines 30 to col. 9 lines 9). Kamakura is silent about teaching specifying an expiration date after the monetary value associated with the advertisement expires. ValuPage teaches specifying an expiration date (i.e. the savings are just for this week, even though an expiration date is not written out on this printout, it is inherent that when it is stated on the print out that these are the ValuPage savings for this week, this week is a duration of a week, and the offers expire at the end of the week when next week's ValuPage will be released) (see ValuPage print out lines 8 and 9). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include specifying an expiration date after the monetary value associated with the advertisement expires in Kamakura's invention for the advertising messages to encourage the user to quickly redeem the offer, to maintain an accurate record of how many credits have been rewarded for a given campaign during a specific time period, and to make sure the user can access the information in a meaningful timeframe. And, even though the ValuPage invention is depicted as being carried out

Art Unit: 3622

on a website in the printed embodiment, it could have easily been pasted in the body of the e-mail message itself.

9. Claims 76 and 82 are rejected under U.S.C. 103(a) as being unpatentable over Kamakura in view of Oberndorf and further in view of Official Notice and further in view of Goldhaber et al. Patent Number 5,855,008 (hereinafter Goldhaber).

In reference to claims 76 and 82, Kamakura teaches *the computer readable medium and the method wherein the monetary value is displayed as points (abstract, col. 3 lines 1-56, col. 4 lines 24-31, col. 5 lines 1-7, col. 6 lines 58-67, col. 8 lines 24-28, and col. 9 lines 10-42)*. Kamakura does not specifically teach displaying the point value as currency. Goldhaber teaches displaying the point value as currency (col. 7 lines 5-11 and 51-54, col. 12 lines 55-61, and col. 16 lines 12-23). It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Kamakura's invention the display of the monetary value as currency to enable the users to know how many award dollars they are spending on a given award so that that the user can compare the dollar award value to what the item might cost in a store easily rather than having to try to convert how many points equate a dollar value of the item in a store.

#### **Response to Arguments**

10. After careful review of Applicant's remarks/arguments filed on 05/12/2008, the Applicant's arguments have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to claims 27, 28, and 75, and 81-85 have been entered and considered.

Art Unit: 3622

11. Applicant argues in reference to claim 27 that Obendorf directs a user to a 3<sup>rd</sup> party website where the user makes a selection, which is not the same as electronically determining the user's selection and providing the selected to a 3rd party supplier. The Examiner respectfully disagrees with the Applicant, since making a selection on a website is being electronically.

12. In reference to the cancelled claim 78, which has now been included in claim 27, the Applicant has made a bald assertion that the Examiner did not provide any documentary evidence in support of the Official Notice. This does not constitute a proper challenge to the Official Notice. Per the MPEP 2144.03, "A seasonable challenge constitutes a demand for evidence be made as soon as practicable during prosecution. Thus the applicant is charged with rebutting the well known statement in the next reply after the Office Action in which the well known statement was made." The Applicant has not submitted any rebuttal of the well-known statements, but has merely stated that the Examiner did not provide any documentary evidence in support of the Official Notice. In the paragraph in MPEP 2144.03 immediately preceding the above citing, reference is made to *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420-421 (CCPA 1970) that "Furthermore, the applicant must be given the opportunity to challenge the correctness of such assertions and allegations." Again, the Applicant has not challenged the correctness of the assertions. Bald statements such as the Examiner did not provide any documentary evidence in support of the Official Notice are not adequate and do not shift the burden to the examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would

effectively destroy any incentive on part of the Examiner to use it in the process of establishing a rejection of notoriously well-known facts (*In re Boon*, 169 USP 231 (CCPA 1971)). In addition, the Examiner has provided examples in support of this Official Notice in the previous Office Action and in the body of this Office Action above. Specifically, when a user receives e-mails from retailers, the subject line may say all DVD's on sale, business books on sale, fall coat sale, all shoes on sale, etc. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to have included identification information regarding an advertised product or service in a subject line of the transmitted e-mail to enable the user to know before opening the e-mail, if the e-mail is regarding a product that is of interest to the user at that given time.

13. Applicants additional remarks addressed to the new claim limitations have been addressed in the rejection necessitated by the amendments.

***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Point of Contact***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

/NAMRATA BOVEJA/

Examiner, Art Unit 3622  
/Raquel Alvarez/

Application/Control Number: 10/790,991  
Art Unit: 3622

Page 11

Primary Examiner, Art Unit 3688

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|--|-------------------------|---|
| <b>Application Number</b><br> | Application/Control No. | Applicant(s)/Patent under Reexamination |
|  | 10/790,991              | LOTVIN ET AL.                           |
| Examiner   | Art Unit                |   |
| PINKY BOVEJA   | 3622                    |   |